

REMARKS/ARGUMENTS

In the Final Office Action mailed January 30, 2007 claims 1-3, 5-10 and 15-18 stand rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Final Office Action. All the pending claims at issue are believed to be patentable over the cited references.

No claims are amended. No claims are cancelled. No claims are added. As such, claims 1-3, 5-10 and 15-18 remain pending.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3, 5-10 15-18 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,062,846 to Oh, et al. (hereinafter referred to as "Oh") in view of United States Patent No. 5,330,442 to Green *et al.* (hereinafter referred to as "Green"). Applicants respectfully traverse the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some reason to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *Id.*

Applicants respectfully assert that the references do not teach the claimed invention. The Examiner fails to mention how the references teach an interlocking mechanism, "wherein the vessel clamping inner surface of at least one of the first and second leg members in angular," as

claimed in claims 1-3 and 5-7. The Examiner admits, at page 2 of the pending Office Action, that Oh fails to teach a ridge/tongue and groove or angular interlocking mechanism, as claimed in claims 8-10 and 15-18. At page 5 of the Office Action, the Examiner claims that “Green discloses a second embodiment wherein a ridge portion 222 protrudes from a continuous portion 221 of the vessel clamping inner surface of the first arm and a groove portion 212 formed along and discontinuously recessed from a continuous portion of the vessel clamping inner surface of the second arm 210...” Applicants respectfully disagree. Green does not disclose the claimed ridge and groove portions.

In one configuration, Green discloses an “arm 120 include[ing] inner surfaces 122a, 122b and 122c oriented generally parallel to side wall 102 and surfaces 124a and 124b oriented generally parallel to top surface 101,” as shown in FIGS. 3, 4 and 7. See Green at column 4, lines 5-8. As such, these are adjacent surfaces, which fail to constitute “a ridge portion formed along and discontinuously protruding from a continuous portion of the vessel clamping inner surface of the first and second leg members and a groove portion formed along and discontinuously recessed from a continuous portion of the vessel clamping inner surface of the other” leg, as claimed in claim 8-10 and similarly claimed in 15-18.

In an alternate configuration, Green describes a so-called “elongated ridge 222” adapted to engage detent 212. See Green at column 5, lines 1-2. This “elongated ridge 222,” however, curves continuously from the inner leg surface, as shown in FIG. 9. Thus, it fails to “discontinuously protrud[e]” from the otherwise “continuous portion of the vessel clamping inner surface,” which provides the disclosed occlusion properties of Applicants’ invention, as claimed in claims 8-10 and 15-18. Similarly, the detent 212 recesses continuously from the inner

surface of the other leg and thus, fails to “discontinuously recess[,]” as claimed in claims 8-10 and 15-18.

Moreover, “in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary [following recent rule clarification by the Supreme Court] to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” Memorandum from Margaret Focarina, United States Patent & Trademark Office (“PTO”) Deputy Commissioner for Patent Operations, to PTO Technology Center Directors on May 3, 2007. Thus, it remains true that “there must be some reason for the combination other than the hindsight gleaned from the invention itself,” as disclosed by the present applicant’s disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

Here, the Examiner completely fails to cite a reason to combine the references with respect to claims 1-3 and 5-7. With respect to claims 8-10 and 15-18, at page 5, the Examiner claims that the “ridge and groove configuration provides for a high degree of clamping force that would be optimal for vessel occlusion, clip retention or suture retention.” However, it is clear that Applicants’ invention solves a different problem than providing a clamping force. Applicants teach that a ligating clip may include “an interlocking tissue-securing mechanism integral to the inner surfaces of the legs of the clip that serves to secure the clip to the vessel and prevent longitudinal movement of the clip relative to the vessel when the clip is in a closed position.” Applicant’s Specification at page 6. Thus, the problem solved by Applicants’ invention is the prevention of longitudinal movement of the clip relative to the vessel, rather than the providing of a higher degree of clamping force. Apart from the Applicants’ teachings, there

would be no reason to combine the ligating clip having asymmetrical legs disclosed by Oh with features of the suture retaining clip disclosed by Green.

The Examiner has failed to identify "some reason for the combination other than the hindsight gleaned from the invention itself." See *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143. Instead, the Examiner impermissibly uses hindsight in asserting that the present invention is rendered obvious. At least because Green discloses a clip used for retaining sutures, not a clip for ligation of ducts/vessels as discussed in Oh and Applicants' disclosure, it would not be obvious to one of ordinary skill in the art to combine the cited references in the manner claimed by Applicants.

In light of the above arguments regarding Oh and Green, the cited references do not teach or suggest all the elements to support a finding of obviousness. Therefore, claims 1-3, 5-10 and 15-18 are allowable. As such, Applicants respectfully request the rejection to these claims be removed.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

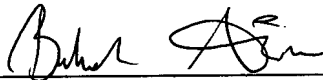
Docket No. 59474.21700
Application No. 10/763,439
Customer No. 30734

Patent

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21700.

Respectfully submitted,

BAKER & HOSTETLER LLP



Bukola Aina
Reg. No. 56,153

Date: 5/23/07
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1744
Facsimile: 202-861-1783